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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/409,524

Applicant(s)

LEE, EUGENE M.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because of the reasons set forth on the attached PTO-948.  
A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 209A, 209B, 242, and 252. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "208B" has been used to designate both filing documents to Associate B and filing documents to RO/US. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is insufficient antecedent basis in claim 22 for "A computer implemented method."

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
8. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 18-19 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-24 of copending application No.09/460806. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.
10. The original U.S. Patent application No.09/409524 describes a facility “whereby an applicant (or his representative) may file corresponding applications in multiple jurisdictions using multiple associates while automating the preparation of filings in accordance with jurisdiction – and/or associate-specific requirements and/or procedures.” The instant application goes on to describe both quoting fees and completing transactions, specifically “one or more of debiting a deposit accounts, executing a wire transfer, and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system” in claims 18 and 19.
11. The copending U.S. Patent application No.09/460806 further describes detailed methods in which to complete the quotations and transactions for services mentioned above. These methods are inherent in the first described facility, and thus are anticipated by the first application No.09/409524.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
14. Claims 41, 43-47, and 50-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al. (US 6,298,327).
15. As per claim 41 and 44, Hunter teaches a computer implemented method (information system) of preparing one or more intellectual property filings (Abstract, C4 L46-55, C6 L2-11, C6 L16-28, C31 L8-14), said method comprising: receiving a selection of one or more target jurisdictions from an originating computer system (C6 L16-28, C31 L41-51); responsive to the selection, supplying the originating computer system with a computer readable encoding of filing requirements for the selected target jurisdictions (Abstract, C4 L46-55); and receiving in computer readable form, at least one document prepared at the originating computer system in accordance with the computer readable encoding of filing requirements (C30 L64-67, C31 L1-14).
16. As per claim 43, Hunter teaches transmitting, for at least one of the selected target jurisdictions, a computer readable encoding of a technical document for filing the at least one selected target jurisdiction (Abstract, C6 L16-21, C31 L59-60).
17. As per claim 45, Hunter teaches a communications interface for transmitting the transformed intellectual property application data and at least one additional document for filing (Abstract, C7 L61-67, C31 L59-60).

18. As per claim 46, Hunter teaches a data store, responsive to the retrieval interface, for storing the intellectual property application data (C32 L1-2, C33 L4-9, Fig. 2).
19. As per claim 47, Hunter teaches wherein the target includes a target jurisdiction or convention; and wherein the target requirement data includes filing requirements for the target jurisdiction or convention (Abstract, C4 L46-55).
20. As per claim 50, Hunter teaches wherein the target-specific intellectual property application-filing format is an electronic format for transmission to the target (C6 L16-21, C30 L58-62, C31 L59-60).
21. As per claim 51, Hunter teaches an information system embodied as a client application executable on a originating computer and implementing: the selection facility, the retrieval interface to intellectual property application data, the retrieval interface to target requirement data; and the translation facility and including a communications interface to a server application; and wherein at least the target requirement data is hosted by the server application (C30 L58-67, C31 L1-7, C31 L15-51, C32 L26-46).

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-16, 20-22, 24-40, 42, 48-49, 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Bezos et al. (US 6,029,141).

24. As per claim 1, 5, 15, 22, 25, 33, and 56, Hunter discloses a method of operating an information service (information system, one-stop intellectual property filing service, a computer implemented method, and/or an intellectual property filing preparation system) to facilitate preparation of intellectual property documents for filing in one or more of plural target jurisdictions (Abstract, C4 L46-55, C6 L2-11, C6 L16-28, C31 L8-14, C31 L41-51), the method comprising: the distribution and retrieval of form documents to an originating filer for use in preparation of the intellectual property documents for (electronically) filing (Abstract, C6 L16-21, C31 L59-60).
25. Hunter fails to disclose the registering for each of plural associates (attorneys or agents), at least one target jurisdiction and a computer readable encoding of target jurisdiction- and associate-specific form documents therefore.
26. Bezos teaches the registering for each of plural associates (attorneys or agents), at least one target jurisdiction and a computer readable encoding of target jurisdiction- and associate-specific form documents therefore (Abstract, C1 L56-61, C24 L1-4).
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the registering for each of plural associates (attorneys or agents), at least one target jurisdiction and a computer readable encoding of target jurisdiction- and associate-specific form documents therefore, as disclosed by Bezos in the system disclosed by Hunter, for the advantage of operating an information service to facilitate preparation of intellectual property documents with the ability of users to select from a list of registered associates, in which to file the intellectual property documents.



28. As per claims 35-36 and 49, Hunter discloses claim 44, and both Hunter and Bezos disclose claim 33. Furthermore, it would have been obvious to include contents of a priority application, data retrieved from a docket system, and/or a priority application corresponding to a previously filed intellectual property application – since, it is obvious to include this information within the intellectual property application process, and all are well known information fields that are part of the application process at the United States Patent and Trademark Office.
29. As per claim 52, Hunter discloses a computer program product (computer readable encoding) encoded in a computer readable medium (Abstract, C7 L58-60, C34 L4-30, Fig.1 #9), the computer program product comprising: retrieval code executable to retrieve, in accordance with the selection, a computer readable encoding of specific filing requirements (including form documents); document preparation code executable to prepare one or more documents in accordance with the retrieved requirements (from a data store); and filing initiation code (an enumeration, for transmission to a computer) executable to transmit the prepared documents for filing (C32 L26-57, C34 L4-30).
30. Hunter fails to disclose the ability to select one or more target jurisdictions and respective associates (including specific documentation) from amongst a set of target jurisdictions and associates therefore.
31. Bezos teaches the ability to select one or more target jurisdictions and respective associates (including specific documentation) from amongst a set of target jurisdictions and associates therefore (Abstract, C1 L56-61, C24 L1-4).

32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the ability to select one or more target jurisdictions and respective associates (including specific documentation) from amongst a set of target jurisdictions and associates therefore, as disclosed by Bezos in the system disclosed by Hunter, for the advantage of creating a computer program product with the ability to select from a plurality of registered associates.
33. Claims 17-19, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Bezos as applied to claims 1-16, 20-22, 24-34, 37-40, 42, 48, 52-56 above, and further in view of Ferguson et al. (5,819,092).
34. As per claim 17-19, and 23, Hunter and Bezos disclose both claim 15 and 22. However, neither Hunter nor Bezos teach quoting fees associated with both the target jurisdiction and the associate coincident with the selection, wherein the supplying of the computer readable encoding of one or more form documents, transacting the quoted fees (wherein the transaction includes one or more of debiting a deposit account, executing a wire transfer, and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system) coincident with the one or more of the selection, the receiving of filing documents, and the filing in the selected target jurisdiction is contingent upon authorization by the user of the quoted fees.
35. Ferguson teaches quoting fees associated with both the target jurisdiction and the associate coincident with the selection, wherein the supplying of the computer readable encoding of one or more form documents, transacting the quoted fees (wherein the transaction includes one or more of debiting a deposit account, executing a wire transfer,

and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system) coincident with the one or more of the selection, the receiving of filing documents, and the filing in the selected target jurisdiction is contingent upon authorization by the user of the quoted fees (Abstract, C4 L28-32, C4 L51-57, C8 L63-67, C9 L1-9, C29 L36-55, C38 L55-59, C39 L1-8, Figure 16, Figure 24).

36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included quoting fees associated with both the target jurisdiction and the associate coincident with the selection, wherein the supplying of the computer readable encoding of one or more form documents, transacting the quoted fees (wherein the transaction includes one or more of debiting a deposit account, executing a wire transfer, and electronically authorizing payment of the quoted fees using a credit card, debit card or other payment system) coincident with the one or more of the selection, the receiving of filing documents, and the filing in the selected target jurisdiction is contingent upon authorization by the user of the quoted fees, as disclosed by Ferguson, in the system disclosed by Bezos in the system disclosed by Hunter, for the advantage of operating an intellectual property filing service with the capability of quoting and transacting fees coincident with said service.

### *Conclusion*

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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38. The following patent is cited to further show the state of the art with respect to application processing systems in general:

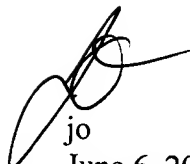
U.S. Pat. No. 5,995,947 to Fraser et al.

U.S. Pat. No. US 6,385,594 B1 to Lebda et al.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Friday, 8am - 4:30pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

41. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
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June 6, 2002

